

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Appl. No.** : 09/890,702 **Confirmation No.:** 6219  
**Applicant** : Claudio Cabano  
**Filed** : January 9, 2002  
**Title** : METHOD FOR FINDING MEMBERS OF A COMMON  
: INTEREST GROUP  
**TC/AU** : 2684  
**Examiner** : Sujatha R. Sharma  
  
**Docket No.** : 33835  
**Customer No.:** 116

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION UNDER 37 CFR 1.131**  
**ESTABLISHING PRIOR INVENTION**

Sir:

This Declaration under 37 CFR 1.131 is filed along with supporting material and an Amendment in response to the Office action of December 22, 2006, and should be considered by the Examiner in light of the response.

**DECLARATION UNDER 37 CFR 1.131**  
**ESTABLISHING PRIOR INVENTION**

We, as inventors in the above-identified patent application, hereby declare as follows:

1. Our residences, post office addresses, and citizenship are as stated below next to our names.

2. In Switzerland, on or before May 19, 1999, we conceived, individually or in concert, of a method and system allowing users of portable devices to find and identify members of a common interest group, to which the above-referenced U.S. patent application is directed.

3. We have read and understood the above-referenced U.S. patent application, including entered claims 1-52 as presently amended and new claim 53 as presently provided.

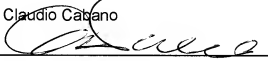
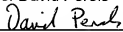
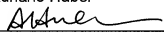
4. It is our belief that the whole invention as set forth at least in Claims 1, 40-42 and 51-53 of the above-referenced patent application was in our possession on or before May 19, 1999. Specifically, with reference to the cited claims, our invention included a method and apparatus (or system) for building at least one database in which a plurality of interest groups are stored and profile information, including characteristics of the members of the interest groups, are also stored. Furthermore, these interest groups would include users of terminals or mobile devices. Also provided is at least one server accessible from within a radio network for accessing the data in the database, and for sending a message to at least one of the members of the common interest group if another member (or members) is in the vicinity of the member of the interest group. The user can be detected in the vicinity by, for example, a GPS system. The provided

message can include profile information of the member(s) in the vicinity, which, in turn, could include identification characteristics of those member(s). Furthermore, the mobile device could provide the profile information of the member(s) in the vicinity to the receiving member and, if identification characteristics are provided in the message, provide such characteristics of the member(s) in the vicinity. This information can thus be used for enabling the identification of the member(s) in the vicinity by the member that receives the information, for example via the display on his mobile device. This recognition could occur even when the member receiving the information has never seen the member(s) in the vicinity.

5. Further, it is our opinion and belief that the attached disclosure information (along with its translation into English, where appropriate), which was captured for the purpose of preparing a patent application and is dated prior to the date of May 19, 1999, provides documentary evidence that the invention, as described in the cited claims and as described in paragraph 4, above, was in our possession prior to the date of May 19, 1999. Our opinion is supported by the attached mapping of the information of this disclosure to the language of the independent claims as shown and described in Appendix A, as prepared by our representative and reviewed by us. Although this attached disclosure is some evidence of state of the invention at the time of its generation, it does not necessarily provide the complete state of the invention as it existed at the time of its generation, as additional features and detail not found in this disclosure were also in our possession at that time as well.

6. Our signatures below provide our agreement that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that

such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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Attachments:

Appendix A (11 pp.)

Disclosure (5 pp.) and Translation (2 pp.)

**Memo**

FS 87

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Erfinder

From Adriano Huber, David Perels, Claudio Cabano

Copy to Eric Lauper

Date [REDACTED]  
Subject Mobile Meet Friends and Business Partners

Cc

**Patent Idea for Mobile Meet Friends and Business Partners**

**Abstract/Scope**

The post-industrial society is changing quickly. People are losing their roots, need to work in a more interconnected world, need to meet other people, need to keep contact with older friends or business partners. This applies both to the private environment as to the business environment.

The introduction of new mobile computing technologies enables the provision of a service that fulfill all these needs. This description addresses the methods necessary to provide these services.

**Functionality**

- Different Groups: User, Group, Community
- Create/Admin User, Group, Community
- Personal / Business / Info
- Profiling
- Loyalty programs
- Preferred Meeting Points
- Alerts
- Meetings
- Active/Passive meeting establishment (push/pull)
- Positioning vs. privacy
- Anonymity vs. Certification of identity
- Negotiation/confirmation
- Preferred I/O (various devices or access methods)
- Device
- Web Homepage
- Fundgrube
- Conferences

## Memo

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Games

Communities: anonymous, temporary, ....

### Technical

Localisation/Polling

Bluetooth, short range

Broadcasting (for parties, broadcast an alle der der gleiche Community gehören.)

Database in the Network

Profile brooker (für Roaming, mapping von Profile)

Interfaces (PC, TV, DAB, Mobile, Bluetooth&Jini, Proximity Detector, short range detectors, pager, mail, ...)

Web interface

Download von Profiles to the phone (phone, organiser, watch).

2 possible solutions:

- 1) proximity detector -> triggers the process when corresponding transmitter is in range (Lovegetty priciple)
- 2) network side monitoring of all subscribers participating

In order not to continuously monitor the interactions some meeting points can be defined. The server checks the positions only when near to the meeting points.

### Profile:

- alter etc
- fotos
- interessen
- an Ausstellungen gegangen
- schlaue funktion um profil auf

### Admin

Timedependent

User / Group / Community

Location (Meeting Points)

Personal profile: new friends, old friends, new business partners, old business partners.

Device, I/O interfaces

**Possible interested partners for such a service**

Swisscom (Mobile, DM, Broadcast)

Partners (Branding...)

Meeting Points: Loeb, MacDonalds, Lorenzini, Kinco, SBB

SRG,DRS, Local,... (?)

**Device**

Mobile Phone

New: special device with GPS, GSMlight, watch, clips,...

**Technical solutions**

get in the system/ subscribe the service

set up a group

register for a group

activate the monitoring or the beacon transmitter (2 possible solutions)

trigger the process (the database check) when near to a Meeting Point or near a

trigger the process when near to an active transmitter

information of possible meeting

negotiation of credentials

communication (possibility to directly call the user)

guidance to the meeting

get out from the system/ unsubscribe the service

**Memo**

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Profilierung datenbank

- profilierung
- koordinaten
- aufträge
- aktiv oder passiv (nicht gestört werden)

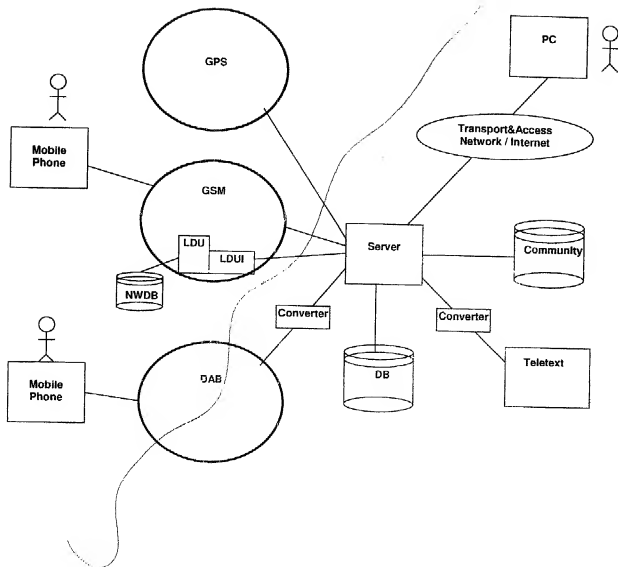
Mapquest/datenbank

Prozess

User schaltet ein.

Monitor für aktive leute





Document 4: Swisscom memo dated [REDACTED]

{{p. 1}}

Memo  
For internal use

only

From [REDACTED] Adriano Huber, David Perels, Claudio Cabano  
Date [REDACTED]  
Subject Mobile Meet Friends and Business Partners

Patent idea for Mobile Meet Friends and Business Partners

Abstract/Scope

{{(already in English)}}

Functionality

{{(already in English save the word "Fundgrube" which means: "treasure trove")}}

{{p. 2}}

Memo  
For internal use

only

Games

{{(already in English)}}

Technical

Localisation/polling

Bluetooth, short range

Broadcasting (for parties, broadcast to all those who belong to the same community)

Database in the network

Profile broker (for roaming, mapping of profile)

Interfaces (PC, TV, DAB, mobile, Bluetooth & Jini, Proximity Detector, short range detectors, pager, mail...)

Web interface

Download of profiles to the phone (phone, organizer, watch)

2 possible solutions:

{{(already in English)}}

Profile:

- age etc.
- photographs
- interests
- went to exhibition
- smart function for generating profile

#### Admin

{{already in English}}

#### Possible interested partners for such a service

{{already in English}}

#### Device

{{already in English}}

#### Technical solutions

{{already in English}}

{{p. 3}}

#### Profiling database

- profiling
- coordinates
- orders
- active or passive (do not disturb)

Mapquest / database

#### Procedure

User switches on  
Monitor for active people

{{p. 4}}

{{already in English}}

## Appendix A

Below is a mapping of the claims to pertinent materials found in the support documentation.

1           1. (currently amended) A method for finding members of a  
2   common interest group with a mobile device, said method  
3   comprising the steps of:  
4       building at least one database [pg. 2: under technical:  
5       "database in the network"; pg. 5: database block] in  
6       which a plurality of interest groups are stored [pg.  
7       1 "different groups" pg. 3 "set up a group" and  
8       "register for a group"], these interest groups  
9       comprising users of terminals [pg. 5 terminal blocks],  
10      storing the database in at least one server accessible from  
11      within a radio network, [pg. 1: "web homepage"; pg. 2:  
12      "database in the network"; pg. 5: server block  
13      connected to database block]  
14      sending a message to at least one of said members if he is  
15      in the vicinity of another of said members of the  
16      common interest group, [pg. 1: "alerts" pg. 2:  
17      "proximity detector triggers process" and "broadcast  
18      to all those who belong to same group"; pg. 3 "trigger

19           the process when near to an active transmitter" and  
20           "communication (possibility to directly call user")]  
21           wherein said message includes identification  
22           characteristics [pg. 2: Profile includes photograph,  
23           age, etc.]; and  
24           said mobile device [pg 5 "mobile phone"] providing said  
25           identification characteristics to said at least one of  
26           said members for enabling the identification of the  
27           another of said members by the one of said members  
28           [consequence of identification characteristics].

1           40. (currently amended) A system with which members of a  
2           common interest group can find other members, comprising:  
3           at least one server accessible from a radio network [pg. 1:  
4           "web homepage"; pg. 2: "database in the network"; pg.  
5           5: server block connected to database block], in which  
6           at least one database [pg. 2: under technical:  
7           "database in the network"; pg. 5: database block]  
8           including a plurality of interest groups stored  
9           therein [pg. 1 "different groups" pg. 3 "set up a  
10           group" and "register for a group"], these interest  
11           groups comprising mobile phone users [pg. 2 "download  
12           to phone"; pg 5 "mobile phone"],

location determining means for monitoring the location of  
the members [pg. 2 "proximity sensor"; pg. 5, "GPS"],  
means for determining if one or more of the members of the  
common interest group are simultaneously situated  
within a predefined distance of each other [pg. 2  
"proximity sensor" and "in range"],  
means for sending messages if it is determined that said  
one or more of the members of the common interest  
group are simultaneously situated within said  
predefined distance of each other [pg. 1: "alerts" pg.  
2: "proximity detector triggers process" and  
"broadcast to all those who belong to same group"; pg.  
3 "trigger the process when near to an active  
transmitter" and "communication (possibility to  
directly call user)"] wherein said message includes  
identification characteristics [pg. 2: Profile  
includes photograph, age, etc.], and  
said mobile device including means providing said  
identification characteristics to said members [pg. 2:  
"download profiles to phone"; pg. 2 profile includes  
photograph], for enabling said members to recognize  
said one or more of said members [Consequence of  
identification characteristics].

1           41. (currently amended) A method for finding members of a  
2 common interest group with a mobile device, said method  
3 comprising the steps of:  
4           building at least one database [pg. 2: under technical:  
5           "database in the network"; pg. 5: database block] in  
6           which a plurality of interest groups are stored [pg. 1  
7           "different groups" pg. 3 "set up a group" and  
8           "register for a group"], these interest groups  
9           comprising users of terminals [pg. 2 "download to  
10          phone"; pg 5 "mobile phone" and figure generally],  
11          said database including identification characteristics  
12          for at least some of the users [pg. 2: Profile  
13          includes photograph];  
14          storing the database in at least one server accessible from  
15          within a radio network [pg. 1: "web homepage"; pg. 2:  
16          "database in the network"; pg. 5: server block  
17          connected to database block],  
18          sending a message including said identification  
19          characteristics for one of said members to at least  
20          another of said members [pg. 2: "download profiles to  
21          phone"; pg.1 profile includes photograph] if he is in  
22          the vicinity of the another of said members of the  
23          common interest group [pg. 1: "alerts" pg. 2:

24           "proximity detector triggers process" and "broadcast  
25           to all those who belong to same group"; pg. 3 "trigger  
26           the process when near to an active transmitter" and  
27           "communication (possibility to directly call user)],  
28           and  
29           specifically billing a party for said sending of said  
30           message [pg. 2 "profile broker"].

1           42. (previously presented) A method for finding members of  
2           a common interest group with a mobile device, said method  
3           comprising the steps of:  
4           building at least one database [pg. 2: under technical:  
5           "database in the network"; pg. 5: database block] in  
6           which a plurality of interest groups are stored [pg. 1  
7           "different groups" pg. 3 "set up a group" and  
8           "register for a group"], these interest groups  
9           comprising users of terminals [pg. 5 terminal blocks],  
10          storing the database in at least one server accessible from  
11          within a radio network [pg. 1: "web homepage"; pg. 2:  
12          "database in the network";,  
13          storing a predetermined message criterion different from  
14          membership in said common interest group for  
15          determining when a message is sent to one of said



16           members [pg. 3 "active or passive (do not disturb)";  
17           "user switches on monitor for active people"]; and  
18           sending said message to the one of said members if he is in  
19           the vicinity of another of said members and only if  
20           said message criterion is satisfied [Id.], wherein  
21           said message contains physical identification  
22           characteristics [pg. 2: profile information] that  
23           enable the personal recognition of the another of said  
24           members by the one of said members [consequence of  
25           physical identification characteristics].

1           51. (currently amended) A method for finding members of a  
2           common interest group, said method comprising the steps of:  
3           providing a database [pg. 2: under technical: "database in  
4           the network"; pg. 5: database block] for storing a  
5           plurality of digital photographs [pg.2 profile  
6           includes photograph], wherein each of said photographs  
7           corresponds to a different one of the members [pg.2  
8           profile information; pg. 1 "different groups" pg. 3  
9           "set up a group" and "register for a group"],  
10          storing the database in at least one server accessible from  
11          within a radio network [pg. 1: "web homepage"; pg. 2:  
12          "database in the network"; pg. 5: server block

connected to database block],  
determining when one of said members is in the vicinity of  
another of said members utilizing a mobile device of  
the one of said members and a mobile device of the  
another of said members [pg. 1: "alerts" pg. 2:  
"proximity detector triggers process" and "broadcast  
to all those who belong to same group"; pg. 3 "trigger  
the process when near to an active transmitter" and  
"communication (possibility to directly call user)"];  
sending the digital photograph corresponding to the one of  
said members to the mobile device of the another of  
said members when it is determined that the one of  
said members is in the vicinity of the another of said  
members [Id. and pg. 2: Profile includes photograph,  
pg. 2: "download profiles to phone"; pg.1 profile  
includes photograph] and  
utilizing said mobile device of the one of said members for  
enabling the visual identification of the another of  
said members by the one of said members [consequence  
of photograph].

52. (previously presented) A method for finding members of  
a common interest group, said method comprising the steps of:

3 providing a database for storing identifying information  
4 about each of said members [pg. 2: **profile**  
5 **information**],  
6 storing the database in at least one server accessible from  
7 within a radio network [pg. 1: "web homepage"; pg. 2:  
8 "database in the network"; pg. 5: **server block**  
9 **connected to database block**],  
10 determining when one of said members is in the vicinity of  
11 another of said members utilizing a mobile device of  
12 the one of said members and a mobile device of the  
13 another of said members [pg. 1: "alerts" pg. 2:  
14 "proximity detector triggers process" and "broadcast  
15 to all those who belong to same group"; pg. 3 "trigger  
16 the process when near to an active transmitter" and  
17 "communication (possibility to directly call user)"];  
18 sending said identifying information corresponding to the  
19 one of said members to the mobile device of the  
20 another of said members when it is determined that the  
21 one of said members is in the vicinity of the another  
22 of said members [pg. 2: "download profiles to phone";  
23 **pg. 2 profile includes photograph**],  
24 said mobile device of the one of said members using said  
25 identifying information for display to the one of said

26 members for enabling identification of the another of  
27 said members by the one of said members , and  
28 the one of said members getting into direct contact with  
29 the another of said members by using the displayed  
30 identifying information for identifying the another of  
31 said members [pg. 1 "preferred meeting points",  
32 "meetings", "conferences",pg. 3 "meeting points"].

1 53. (new) A method for finding members of a common interest  
2 group with a mobile device, said method comprising the steps of:  
3 building at least one database [pg. 2: under technical:  
4 "database in the network"; pg. 5: database block] in  
5 which a plurality of interest groups are stored [pg. 1  
6 "different groups" pg. 3 "set up a group" and  
7 "register for a group"], users of terminals [pg. 5  
8 terminal blocks] being members of these interest  
9 groups,  
10 providing at least one server accessible from within a  
11 radio network for utilizing said database [pg. 1: "web  
12 homepage"; pg. 2: "database in the network"; pg. 5:  
13 server block connected to database block], and  
14 said server sending a message to at least one of said  
15 members if he is in the vicinity of another of said

16           members of the common interest group [pg. 1: "alerts"  
17           pg. 2: "proximity detector triggers process" and  
18           "broadcast to all those who belong to same group"; pg.  
19           3 "trigger the process when near to an active  
20           transmitter" and "communication (possibility to  
21           directly call user")], wherein  
22           said message contains personal profile information related  
23           to the another of said members [pg. 2: "download  
24           profiles to phone"; pg. 2 profile includes personal  
25           information].

REMARKS

The above claims have been mapped to the supporting the disclosure information attached to the DECLARATION UNDER 37 CFR 1.131 ESTABLISHING PRIOR INVENTION to which this appendix is also attached and made part of. Pointers to least some of the pertinent supporting materials are provided in bold brackets after the relevant claim element/limitation, but there may be additional supporting material provided in the disclosure. The date information has been redacted from this document, but is prior to May 19, 1999, as supported, under penalty of perjury, by the inventors' declaration. It is noted that this disclosure information is not necessarily a complete representation of the invention as it existed at the time of its generation, but is instead merely some evidence of the actual invention in the possession of the inventors for supporting the declaration of the inventors.

Please note that the attached disclosure information is provided with some of the material in the Swiss German language, and a translation of this material is provided at the end of the disclosure as an additional attachment.

This appendix has been prepared by the below signed representative of the applicant and has been reviewed by applicant and made part of, and is incorporated in, the Declaration to which it is attached.

Respectfully Submitted,

PEARNE & GORDON, LLP

By: \_\_\_\_\_ / Robert F. Bodi / \_\_\_\_\_

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